

REMARKS

Claims 1-4 and 23 are pending in this application. Claims 1, 4 and 23 were amended in this response. No new matter has been added as a result of the amendment.

The present document is identical to that filed March 6, 2006, with the exception of Claim 5 being correctly identified as Claim 23. Claims 12-22 were previously canceled in the preliminary amendment dated November 14, 2000, and claims 5-11 were previously canceled in the response to restriction requirement dated December 3, 2003.

Claims 1, 2, 4 and 23 stand rejected under 35 U.S.C. §102(e) as being anticipated by *Bush et al.*, U.S. Patent No. 5,475,585. Claim 2 has been rejected under 35 U.S.C. §103(a) as being unpatentable over *Bush et al.*, U.S. Patent No. 5,475,585 as applied to claim 1. The Applicants respectfully traverse the rejections. Favorable reconsideration is respectfully requested.

Specifically, the cited art, alone or in combination, does not disclose at least “means for communicating a digital advertisement . . . using Internet transfer protocols” and “means for requesting, displaying and responding to digital advertising [presented using Internet transfer protocols]” as recited in claim 1 and similarly recited in claims 4 and 5. The amendments are being presented to clarify Applicant’s position in the previous office actions that demonstrated that *Bush* does not disclose these features. As was argued previously, *Bush* discloses a video broadcasting system that transmits video menus to a television or video screen via RF carrier signals, and further incorporates credit-card swipers and special keypads for user input (col. 3, lines 21-30; col. 5, lines 34-44, line 65 to col. 6, line 9; col. 7, lines 22-35). This configuration is completely different from the claimed features in the present application.

Under the MPEP, the USPTO must apply 35 U.S.C. 112, sixth paragraph in appropriate cases, and give claims their broadest reasonable interpretation, in light of and consistent with the written description of the invention in the application (MPEP 2181). If a prior art reference purportedly teaches identity of function to that specified in a claim, then the Examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function (MPEP 2182). If the specification

defines what is meant by the limitation for the purposes of the claimed invention, the examiner should interpret the limitation as having that meaning (MPEP 2182).

Applicant submits that the Examiner has not met the burden imposed by the MPEP to explain how the configuration in *Bush* is equivalent to the present claims. The communication channel in *Bush* is separate and distinct from the broadcast channel that delivers a menu to the user terminal, and it delivers the purchase message to a different destination from the source of the advertisements (menu). There is no mention of any kind of network transfer protocols or hypertext conventions of the WWW (see, e.g. specification page 11, second paragraph). Accordingly *Bush* does not disclose, teach or suggest a purchase means or the other means set forth in the pending claims.

Applicant also maintains that the examination of the present application is not abiding by the requirements of 35 U.S.C. §112(6), as discussed above. The Advisory Action stated that “the only structure needed to perform the recited functionality is read into the claims from the specification. In the instant case, a processor, storage device and network (as taught by the *Bush* reference) are needed to perform the recited functionality.” The Office Action has incorrectly maintained that the means-plus-function language is limited to the structure defined in the specification (see page 4). Yet this approach is inconsistent with that promulgated by the courts and the USPTO:

[T]he application of a prior art reference to a means or step plus function limitation requires that the prior art element perform the identical function specified in the claim. However, if a prior art reference teaches identity of function to that specified in a claim, then under *Donaldson* an examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function . . . If the specification defines what is meant by the limitation for the purposes of the claimed invention, the examiner should interpret the limitation as having that meaning.

See MPEP 2182. The Office Action states that “*Bush* discloses a processor, storage device, and network which performs the functionality in claims 1, 2 and 4; therefore, it is understood that *Bush*’s processor, storage device and network are programmed to specifically perform these functions” (bottom of page 3 of Office Action). However, this ignores Applicant’s

arguments showing that different functions are being employed by the configuration of *Bush*, namely a video broadcasting system that transmits video menus to a television or video screen via RF carrier signals.

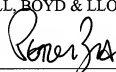
The “means for communicating a digital advertisement” is clearly disclosed as being communicated by a merchant computer over a computer network, having advertisements stored in databases (see, e.g., specification pages 10-11). In contrast, *Bush* discloses a transmission being made by a transmitting source using a video signal that includes characters generated from a video character generator 206 (col. 1, lines 56-67; col. 3, lines 1-7; col. 5, lines 50-59; col. 6, lines 25-34). Also, the “means for requesting, displaying and responding to digital advertising” are supported in the specification, for example, on pages 11-13, and illustrate the use of links, and provides HTML forms for interacting with users. To date, it has still not been explained how this configuration is an equivalent of Applicant’s means-plus-function claims. In any case, Applicant submits that in light of the present amendments, it is clear that *Bush* fails to teach these features.

Regarding claim 2 Applicant kindly requests that supporting documentation be provided for the official notice taken in the rejection, provided that the rejection is maintained in its present form in subsequent office actions.

For at least these reasons, the Applicants submit that the rejections under 35 U.S.C. §102 and §103 are improper and should be withdrawn. An early Notice of Allowance is earnestly requested. If any fees are due in connection with this application as a whole, the Examiner is authorized to deduct such fees from deposit account no. 02-1818. If such a deduction is made, please indicate the attorney docket number (115274-00015) on the account statement.

Respectfully submitted,
BELL, BOYD & LLOYD LLC

BY



Peter Zuffa
Reg. No. 48,196
Customer No. 24573
Phone: (312) 807-4208

Dated: April 14, 2006